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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,327	12/05/2003	Penny L. Gerstner	1538US1.014033.018	1326
69603 7590 12/24/2009 MOORE & VAN ALLEN, PLLC FOR BOFA 430 DAVIS DRIVE, SUITE 500 POST OFFICE BOX 13706 RESEARCH TRIANGLE PARK, NC 27709			EXAMINER EBERSMAN, BRUCE I	
			ART UNIT 3691	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,327	Applicant(s) GERSTNER ET AL.	
	Examiner BRUCE I. EBERSMAN	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant filed an amendment after non-final rejection on 8/26/09. Claim 1 has been amended, no claims have been canceled or withdrawn, therefore claims 1-35 pending. After careful consideration of the applicant's arguments and amendments, the examiner finds them moot in view of new grounds of rejection for amended claim 1 and dependents 2-10, and non-persuasive in regards to non-amended claims 11-35.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-35 rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 7376587 to Neofytides..

As per claim 11, Neofytides et al. teaches a computer program product comprising a computer-readable storage medium having a computer program embodied therein for enabling a financial institution to authorize recurring third-party transactions for an account on behalf of an account holder (See col. 1, lines 57, through col. 2, line 2, and col. 6, line 37, through col. 7, line 23, which discusses hardware and software for

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implementing an electronic money transfer, including recurring transactions), the computer program further comprising:

instructions for receiving account-holder requests, wherein specific requests from among the account-holder requests authorizes specific third party participants to perform a plurality of the recurring third-party transactions on behalf of the account

holder (See col. 1, lines 57, through col. 2, and col. 5, line 38, through col. 6, line 9, which discusses recurring transactions; and, furthermore, how a payor initiates debiting his/her bank account in an electronic monetary transaction);

instructions for matching the specific requests from among the account-holder requests to the specific third-party participants (See col. 11, line 62, through col. 12, line 8, which discusses matching requests to transfer money using a security question);

instructions for forwarding the specific requests to the specific third-party participants on behalf of the account holder (See col. 11, lines 48-56, which discusses sending a payee an email to confirm payment from a payor);

instructions for receiving participant confirmations from the specific third-party participants (See col. 11, lines 48, through col. 12, line 8, which discusses how a payee confirms approval of an electronic money transfer); and

instructions for forwarding an account-holder confirmation of the participant confirmations of the specific requests to the account holder (See col. 12, lines 34-46, which discusses how a payor confirms the transaction).

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Claims 12-14 recite equivalent limitations to claims 2-4, respectively, and are therefore rejected using the same art and rationale set forth above.

Claim 15 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

Claim 16-20 recites equivalent limitations to claim 6 and are therefore rejected using the same art and rationale set forth above.

As per claim 21, Neofytides et al. teaches an apparatus to enable a financial institution to authorize recurring third-party transactions for an account on behalf of an account holder (See col. 1, lines 57, through col. 2, line 2, and col. 6, line 37, through col. 7, line 23, which discusses hardware and software for implementing an electronic money transfer, including recurring transactions), the apparatus comprising:
means for receiving account-holder requests wherein specific requests from among the account-holder requests authorizes specific third party participants to perform a plurality of the recurring third-party transactions on behalf of the account holder (See col. 1, lines 57, through col. 2, and col. 5, line 38, through col. 6, line 9, which discusses recurring transactions; and, furthermore, how a payor initiates debiting his/her bank account in an electronic monetary transaction);
means for matching the specific requests from among the account-holder requests to the specific third-party participants (See col. 11, line 62, through col. 12, line 8, which

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discusses matching requests to transfer money using a security question);

means for forwarding the specific requests to the specific third-party participants on behalf of the account holder (See col. 11, lines 48-56, which discusses sending a payee an email to confirm payment from a payor);

means for receiving participant confirmations from the specific third-party participants (See col. 11, lines 48, through col. 12, line 8, which discusses how a payee confirms approval of an electronic money transfer); and

means for forwarding an account-holder confirmation of the participant confirmations of the specific requests to the account holder (See col. 12, lines 34-46, which discusses how a payor confirms the transaction).

Claims 22-24 recite equivalent limitations to claims 2-4, respectively, and are therefore rejected using the same art and rationale set forth above.

Claim 25 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 26, Neofytides et al. teaches a computer-readable storage medium comprising a system to enable a financial institution to authorize recurring third-party transactions for an account on behalf of an account holder (See col. 1, lines 57, through col. 2, line 2, and col. 6, line 37, through col. 7, line 23, which discusses hardware and software for implementing an electronic money transfer, including recurring

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transactions), the system comprising:

a user interface to receive account-holder requests, wherein specific requests from among the account-holder requests authorizes specific third party participants to perform a plurality of the recurring third-party transactions on behalf of the account

holder (See figure 1, col. 1, lines 57, through col. 2, and col. 5, line 38, through col. 6, line 9, which illustrates and discusses a user or payer computer, recurring transactions, and how a payor initiates debiting his/her bank account in an electronic monetary transaction);

at least one engine operatively connected to the user interface, the at least one engine to match the specific requests from among the account-holder requests to the specific third-party participant (See figure 1, and col. 5, line 38, through col. 6, line 9, which illustrates and discusses a payment enabler or intermediary, and how a payor initiates debiting his/her bank account in an electronic monetary transaction);

a third-party participant interface to forward the specific requests to the specific third-party participants, the third-party participant interface operatively connected to the at least one engine (See figure 1, and col. 11, line 62, through col. 12, line 8, which illustrates and discusses a payee or third party computer, and matching requests to transfer money using a security question)and ;

a least one data repository operatively connected to the at least one engine, the at least one data repository further comprising third-party participant profiles (See col. 10, line 49, through col. 11, line 19, which discusses registering an individual or payee's profile,

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storing the profile, and confirming the profile according to a preferred method); and a fulfillment system to provide account-holder confirmation of the specific requests, the fulfillment system operatively connected to the at least one engine (See col. 12, lines 34-46, which discusses how a payor confirms the transaction).

Claim 27 recites equivalent limitations to claim 2 and is therefore rejected using the same art and rationale set forth above.

Claim 28 recites equivalent limitations to claim 6 and is therefore rejected using the same art and rationale set forth above.

Claim 29 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 30, Neofytides et al. teaches wherein the account-holder communication preferences comprises at least one of electronic and paper communication preferences (See claim 1, which discusses communicating by an email address).

Claim 31 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

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Claim 32 recites equivalent limitations to claim 30 and is therefore rejected using the same art and rationale set forth above.

As per claim 33, Neofytides et al. teaches wherein the user interface is operable to receive the account-holder requests from the account-holder over the internet (See figure 1, which illustrates receiving user requests over the internet).

Claims 34 & 35 recite equivalent limitations to claim 33 and are therefore rejected using the same art and rationale set forth above.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 7376587 to Neofytides and further in view of US Patent Publication 20030191711 to Jamison

As per claim 1, Neofytides et al. teaches a method of processing account-holder requests to authorize recurring a plurality of third-party transactions for an account at a

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financial institution on behalf of the account holder (See col. 1, lines 57, through col. 2, line 2, and col. 6, line 37, through col. 7, line 23, which discusses hardware and software for implementing an electronic money transfer, including recurring transactions), the method comprising:

receiving, at the financial institution, the account-holder request to authorize the plurality of third party transactions (See col. 5, line 38, through col. 6, line 9, which discusses how a payor initiates debiting his/her bank account in an electronic monetary transaction matching using a computer at least one specific request from among the account-holder requests to at least one specific third-party participant (See col. 11, line 62, through col. 12, line 8, which discusses matching requests to transfer money using a security question, computers are discussed through);

forwarding the at least one specific request to the at least one specific, third-party participant on behalf of the account holder (See col. 11, lines 48-56, which discusses sending a payee an email to confirm payment from a payor);

receiving, at the financial institution, at least one participant confirmation from the at least one specific third-party participant (See col. 11, lines 48, through col. 12, line 8, which discusses how a payee confirms approval of an electronic money transfer), wherein the at least one participant confirmation comprises a confirmation that the at least one specific third-party participant's accounting system has been updated based on the at least one specific request (See col. 13, lines 4-14, and col. 14, lines 20-27, which discusses updating transaction files); and

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forwarding, from the financial institution, an account-holder confirmation of the at least one participant confirmation of the at least one specific request to the account holder (See col. 12, lines 34-46, which discusses how a payor confirms the transaction).

Neofytides does not explicitly disclose;

that a third party is defined by" by a third party entity other than the financial institution or account holder;"

Jamison teaches;

by a third party entity other than the financial institution or account holder;

(34, 51, 0084, a system where customer can direct payment of bills on their behalf wherein there is a third party other than the financial institution or the account holder which makes the requests on behalf the customer, the system does it for the customer, system is not related to the bank/financial institution paying said bills)

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to combine the customer automated bill payment system of Jamison with the automatic payment teachings of Neofytides for the motivation of allowing customers to schedule recurring bill payments in an efficient manner. (0026)

As per claim 2, Neofytides et al. teaches establishing a pre-existing list of prospective third-party participants, wherein the at least one specific third-party participant is selected from the pre-existing list (See col. 9, line 52, through col. 10, line 49, which discusses an address book that functions as a source of prospective payees).

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As per claim 3, Neofytides et al. teaches wherein at least one of the forwarding of the at least one specific request to the at least one specific, third-party participant and the receiving, at the financial institution, the at least one participant confirmation from the at least one specific third-party participant is accomplished in accordance with participant communication preferences stored in a participant profile for the at least one specific third-party participant, the participant profile being stored in a data repository comprising participant profiles associated with the prospective third-party participants (See col. 10, line 49, through col. 11, line 19, which discusses registering an individual or payee's profile, storing the profile, and confirming the profile according to a preferred method).

As per claim 4, Neofytides et al. teaches wherein the forwarding, from the financial institution, of the account-holder confirmation of the at least one participant confirmation of the at least one specific request to the account holder is accomplished in accordance with account-holder communication preferences stored in an account- holder profile (See col. 8, lines 26-54, which discusses a user or payor profile and how a user or payor may confirm a money receipt method).

Claim 5 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 6, Neofytides et al. teaches wherein the account-holder requests comprise at least one direct-deposit request to authorize the at least one specific third- party

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participant to periodically direct deposit funds to the account (See col. 1, lines 57, through col. 2, line 2, and col. 4, lines 1-10, which discusses how a user directs recurring money transfer requests to another individual or entity).

Claims 7-10 recite equivalent limitations to claim 6 and are therefore rejected using the same art and rationale set forth above.

Response to Arguments

Applicant filed an amendment after non-final rejection on 8/26/09. Claim 1 has been amended, no claims have been canceled or withdrawn, therefore claims 1-35 pending. After careful consideration of the applicant's arguments and amendments, the examiner finds them moot in view of new grounds of rejection for amended claim 1 and dependents 2-10, and non-persuasive in regards to non-amended claims 11-35.

35 USC 101 - persuasive, and thereby withdrawn in view of amendment to claim 1.

35 USC 102/103(a)

Applicant makes 7 arguments directed to amended claim 1 and dependents, The arguments do not directly address claims 11-35 as, a simple search of each claim for the cited claim language only matches claim 1 or in the case of argument 7, claim 6. Thus, the examiner has only responded to the claims argued.

Further applicant argument p. 9 states that claim 26 has been amended at the suggestion of the examiner. Further claim 6 is said to be amended on page 12 of the applicant's response and no indication of amendment can be found in the claims.

1.(p. 9 of applicant argument) Neofytides does not teach "at least one specific request from among the account-holder requests authorizes a specific party to perform a plurality of recurring third-party transactions on behalf of the account holder"

Applicant appears to argue subject matter not claimed in claim 1. Whereas claim 1 pre-ambles discloses recurring third party transactions, the pre-ambles is not part of the body of the claim. Further, applicant has use the term "recurring a plurality of third- party transactions" However this phrase is awkward. The claim language should recite " a plurality of recurring third-party transactions" to read clearly.

Only unamended claims 11, 21, 26 appear to have the above limitation.

In regards to the argued claim language above, applicant appears to be arguing that 3rd party transactions might not be "by a third party entity other than the financial institution or the account holder" (as per amended claim 1. However, for non-amended claims 11, 21, 26 third party is effectively a different party, and in view of applicant language could be the financial institution or the account holder or a third party.

The examiner on review of the cited portions of Neofytides believes the entirety of the citations are applicable in view of the interpretation. In summary applicant is correct only as it regards to amended claim 1 wherein the third party is now defined to be other than the financial institution or the account holder, thereby changing the claims to render the examiner's cited art moot. New art has been cited for the amended claim language of claim 1 and would be relevant to claims 11-35 if similarly amended.

2.

Applicant's second argument is that a bank is not a financial institution and thus Neofytides does not disclose a financial institution.

Further applicant argues that Neofytides does not teach "to a specific third party" to authorize "multiple recurring third party transactions performed by the specific third party "on behalf of the "account holder."

Applicant appears to argue subject matter not claimed. For example the word multiple does not occur in the claim language. applicant claim language of amended claim 1, and non-amended claims 11, 21, 26 refer to a "plurality" of the recurring third-party transactions on behalf of the account holder" (claim 11).

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However, In this context, plurality means is more than one transaction on behalf of the account holder by a third party. It appears from reading the cited portions, including col. 5-6 that Neofytides does disclose Banks and third party transactions performed on behalf of the account holder or payor. Neofytides uses the term intermediary several times but, intermediary in the context of the claims is a broader claim of a financial intermediary which could be a company, bank, financial institution etc.

Therefore the examiner finds that the applicant's argument to be non-persuasive as applied to the actual claim language.

3. p. 10, para. 2 – applicant argues “receiving at the financial institution, the account holder requests to authorize the plurality of third party transactions” This argument is applicable to claim 1 as per applicant and a text search of said claims. However, in view of amendment, the examiner has added US Patent Publication to Jamison rendering said argument moot.

4. (p.1 para 2) – “forwarding the at least one specific request to the at least one specific third-party participant on behalf of the account holder” Applicant argues that the email confirmation of “Neofytides is not a request, much less not a specific quest to authorize recurring third party transactions. Further the email is not sent on behalf of the account holder nor to the at least one specific third party participant.

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In this case the third-party has been limited by amendment and further, the request is not clearly defined by applicant in such a manner that it could not be an email.

5. (p. 11, para 3, "receiving at the financial institution at least one participant confirmation from at least one specific third-party participant" Again, applicant is arguing the definition of 3rd party which is further defined by amendment of claim 1.

6. (p. 11, para. 4 " applicant argues that the Neofytides reference does not explicitly disclose receiving " a confirmation that the at least one specific third-party participant's accounting system has been updated" based on one specific request"

Applicant is correct that the term accounting system is not used. However, as described presently, applicant is describing the updating of a system that tracks payments or requests. It appears that Neoftides depicts accounting type systems that track participants requests for funds and receipts thereof.

7. p. 12, para. 2, In regards to dependent claim 6, " "how a user directs a money transfer request to another individual or entity" While referring to claim 6 as amended, the examiner finds no current amendment to said claim. However, applicant appears to be arguing that because claim 1 is amended such that the third-party cannot be the

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financial institution or the account holder, that claim 6, "direct depositing" must also be by the third party to periodically deposit funds to the account.

Further applicant uses the term "direct deposit funds to the account." In this context the broadest reasonable interpretation could be direct (send or order) the deposit of funds to an account"

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

2.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRUCE I. EBERSMAN whose telephone number is (571)270-3442. The examiner can normally be reached on 630am-5pm, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691

Bruce I Ebersman
Examiner
Art Unit 3691